

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kenichi HIGASHI, et al.

Application No.: 09/842,248

Confirmation No.: 7514

Filed: April 26, 2001

Art Unit: 1773

For: LAMINATED FILM AND STRUCTURE
COMPRISING SAME

Examiner: D. S. NAKARANI

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is filed in response to an issue raised by the Examiner's Answer that was mailed on September 29, 2006.

Claims 1-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over US 5,725,712 (Spain '712) in view of US 5,829,804 (Saeki '804). Applicants present arguments on pages 3-15 of the Appeal Brief of November 17, 2005, which arguments detailed various defects in the rejection stated by the Examiner. The Examiner addresses this extensive argumentation by Applicants on pages 5-7 of the Examiner's Answer mailed September 29, 2006.

The Examiner's Answer tends to give the impression that the only issue with respect to the rejection of record is concerned with component (E) of the Saeki reference ("it would have been obvious to a person of ordinary skill in the art ... to utilize Saeki et al's composition

without component E in the invention of Spain et al"). This however is not the only differentiation upon which Applicants rely.

As pointed out by Applicants e.g. on page 7 of the Appeal Brief, the Examiner acknowledges that the Spain reference fails to teach a polypropylene substrate containing filler and thermoplastic elastomer – as required for resin layer (B) by the claims herein. Applicants argued, at the top of page 7 of the Appeal Brief, "that the missing element of the present invention, resin layer (B), is not fully taught in Sacki". Emphasis in original.

In the paragraph bridging columns 16-17 of the patent, Spain provides the following teachings regarding a backing sheet:

- The backing sheet is preferably a semirigid, self-supporting, thin, flat sheet of a synthetic resinous material;
- The backing sheet is made from a material which is compatible with an injection-molded plastic material later used to form the structural substrate base of the finished article;
- Preferably, the backing sheet is made from the same or substantially the same polymeric material as the substrate base of the finished article;
- "The material from which the substrate is molded can contain a substantial amount of filler and therefore can produce an imperfect surface on an article molded from the substrate material." (column 17, lines 7-10); and
- The laminate 70 is adhered to the otherwise imperfect surface of the molded substrate to improve the surface characteristics of the substrate panel and produce an outstandingly smooth controlled exterior automotive finish.

The Spain reference thus teaches that incorporation of filler into a substrate causes the substrate to have an imperfect surface. This clearly suggest that incorporation of filler into a backing sheet makes the backing sheet imperfect and consequently deteriorates the appearance. Since appearance is a very important feature for a decorative laminate, the Spain disclosure *teaches away from* the incorporation of filler into a backing sheet.

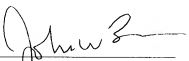
It is axiomatic that is a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is not suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

To utilize the Saeki composition with filler to modify the backing sheet of Spain involves incorporation of filler into the backing sheet – in direct contradiction to the teachings of the Spain reference! For this reason, Applicants respectfully maintain that is would not have been obvious to a person of ordinary skill in the art to utilize the Saeki et al. compositions for making the backing sheet of Spain et al.

The Examiner and the Board are invited to contact Richard Gallagher (Reg. No. 28,781) at (703) 205-8008 with any questions.

Dated: November 28, 2006

Respectfully submitted,

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